

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 13, 2001. At the time of the Office Action, Claims 19, 20, and 22-26 were pending in this patent application. Applicant has amended Claim 19 and has canceled Claims 20, 23, and 24 without prejudice or disclaimer. Applicant respectfully submits that these amendments will not require a new search to be conducted and will not necessitate new or different grounds of rejection. Accordingly, Applicant respectfully requests reconsideration and favorable action in this case.

Claims 19, 22, 25 and 26 are Allowable

The Examiner rejects Claims 19, 22, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 4,623,965 to Wing ("*Wing*") in view of U.S. Patent Number 5,542,487 to Schultz, et al. ("*Schultz*").

Independent Claim 19, as amended, recites the following limitations:

A portable check encoding device, comprising:
an input device operable to receive a check amount from a user and further operable to receive a payee name selected from a list of payee names by the user;
a memory operable to store and recall the list of payee names;
a display operable to display the check amount entered by the user and the list of payee names; and
a portable check printer operable to:
receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and
receive the selected payee name and print the selected payee name in a payee field on the check.

Neither *Wing* nor *Schultz*, whether considered alone or in combination, discloses, teaches, or suggests "an input device . . . operable to receive a payee name selected from a list of payee names by the user; a memory operable to store and recall the list of payee names; [and] a display operable to display . . . the list of payee names," as recited in Claim 19, as amended. *Wing* discloses a portable pocket size check writing apparatus for printing, recording, and maintaining deposits and withdrawals from a checking account. (Column 1,

lines 49-53). *Schultz* discloses a printer unit contemplated for use as a check printer. (Column 3, lines 49-55).

Examiner has admitted that *Wing* and *Schultz* lack the specific teaching of a memory to recall a list of payee names. (Office Action, page 3). Furthermore, although the electronic check writer of *Wing* includes a RAM memory, the memory stores a check register and a transaction list. (Column 5, lines 2-5). The transaction list corresponds with a row of transaction keys (22) that permit the user to select a desired transaction. (Column 2, lines 50-51). Possible transactions include check, deposit, adjust, reconcile, and reports. (Figure 1). Additionally, the device of *Schultz* is merely a printer to be communicatively linked with a portable data collection terminal (71). (Column 6, lines 16-20). The element of a "memory" is completely absent from the apparatus disclosed in *Schultz*. Thus, neither *Wing* nor *Schultz*, whether considered alone or in combination, discloses "an input device . . . operable to receive a payee name selected from a list of payee names by the user; a memory operable to store and recall the list of payee names; [and] a display operable to display . . . the list of payee names," as recited in Claim 19, as amended.

For at least this reason, Applicant respectfully requests reconsideration and the allowance of Claim 19, together with the claims that depend from Claim 19.

The Examiner rejects Claims 20, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Wing* and *Schultz*, and further in view of U.S. Patent Number 5,583,783 to Yasui ("*Yasui*"). Claims 20, 23, and 24 have been cancelled without prejudice or disclaimer and the limitations of these claims have been incorporated into Claim 19.

Claim 19 is not rendered obvious by the combination of *Wing*, *Schultz*, and *Yasui* for the following reasons. Applicant has shown above that (and Examiner has admitted that) *Wing* and *Schultz* do not recite each and every limitation of Claim 19, which has been amended to include the features of Claims 20, 23 and 24. Furthermore, *Yasui* also does not disclose, teach, or suggest the features recited in Claim 19, whether considered alone or in combination with *Wing* and *Schultz*, or with the knowledge of one having ordinary skill in the art at the time the invention was made. Specifically, *Yasui* does not disclose, teach, or

suggest "a display operable to display the check amount entered by the user and display the list of payee names," as recited in Claim 19, as amended. Rather, *Yasui* discloses that payee codes of regular payees are included on a printed template (7) and that a list of registered payee codes is stored in a storage device included in the checkwriter (1), such as ROM (104). (Column 5, lines 48-52). Thus, "when 'PAY TO?' is displayed in step S33, the code of the desired payee, for example '#4,' is typed in step S34, and the enter key (13) is depressed to register the payee." (Column 6, lines 17-21). Alternatively, the payee can also be specified by entering the payee's name by operating the keyboard (4). (Column 6, lines 22-24). Thus, the user can enter a payee code listed on the template or the user can type a payee name, but *Yasui* does not disclose, teach, or suggest "a display operable to display . . . [a] list of payee names," as recited in Claim 19, as amended.

Moreover, assuming for purposes of argument that the proposed combination discloses the limitations of Claim 19, the Examiner has not cited language in either reference or within information commonly known to those skilled in the art that provides the necessary motivation or suggestion to combine these three references. Further, it would not be obvious to one skilled in the art to make the combination. It is a primary purpose of the device of *Wing* to provide a portable, handheld electronic checkbook. Similarly, it is a primary purpose of *Schultz* to provide a check printer to be linked to a portable data collection terminal. The device disclosed in *Yasui* is not portable. Therefore, there is no suggestion to combine features of the electronic checkbook of *Wing* and the check encoding printer of *Schultz* with the non-portable check writer of *Yasui* to yield the portable check encoding device recited in the present claims. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). There is no such suggestion to combine *Wing*, *Schultz* and *Yasui*, and thus Applicant respectfully submits that a rejection of Claim 19 would be improper.

For at least this reason, Applicant respectfully requests reconsideration and the allowance of Claim 19, together with the claims that depend from Claim 19.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicant, at the Examiner's convenience at (214) 953-6986.

Applicant does not believe that any additional fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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MARKED UP VERSION OF CLAIM AMENDMENTS

IN THE CLAIMS

For the convenience of the Examiner, all claims have been presented whether or not an amendment has been made. The claims have been amended as follows:

19. **(Amended)** A portable check encoding device, comprising:
an input device operable to receive a check amount from a user **and further operable to receive a payee name selected from a list of payee names by the user;**
a memory operable to store and recall the list of payee names;
a display **[coupled to the input device and]** operable to display the check amount entered by the user **and the list of payee names;** and
a portable check printer **[coupled to the input device and]** operable to:
receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; **and**
receive the selected payee name and print the selected payee name in a payee field on the check.
20. Please cancel Claim 20 without prejudice or disclaimer.
22. The portable check encoding device, as set forth in claim 19, wherein the check printer is operable to encode the check amount on a MICR line of the check.
23. Please cancel Claim 23 without prejudice or disclaimer.
24. Please cancel Claim 24 without prejudice or disclaimer.
25. The portable check encoding device, as set forth in claim 19, wherein the check printer is further operable to print the check amount alphabetically in an alphabetical amount field and numerically in a numerical amount field on the check.

26. The portable check encoding device, as set forth in claim 19, wherein the check received by the check printer is a blank check, the blank check including an account number but not a payee name or check amount.